



**PETITION FOR FILING PATENT APPLICATION
BY THE ASSIGNEE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Munoz et al.

Serial No.: 09/818,168

Filed: March 27, 2001

For: SYSTEM AND METHOD FOR AUTOMATED
PRESCRIPTION MANAGEMENT

Group Art Unit: 2167

PETITION FOR FILING BY ASSIGNEE

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicant, The Whittier Group, hereby petitions the Commissioner to accept the filing of the above-identified U.S. Patent Application by it, as the party to which the invention disclosed and claimed in the above-identified patent application rightfully belongs, and on behalf of and as agent for the unavailable co-inventor.

An Affidavit is attached hereto providing proof of the pertinent facts concerning the refusal of the inventor to join in the present application for patent and establishing that The Whittier Group has a sufficient proprietary interest in this matter to make application on behalf of and as agent for the inventor, and showing that such action is necessary to preserve the rights of the parties and to prevent irreparable damage.

The name and last known mailing address of the unavailable co-inventor is as follows:

Emre Oksan
1864 W. Palm Drive, Apt. #355
Mount Prospect, IL 60056

The invention was developed under the authorization of The Whittier Group by Michael A. Munoz of Park Ridge, Illinois, Emre Oksan of Mount Prospect, Illinois, and David Raul Munoz of Tacoma, Washington, each of whom was employed by The Whittier Group to do so.

Upon information and belief, based on the precedent which will be discussed below, The Whittier Group is entitled to clear title to the invention and to the above-identified patent application and any patent which issues thereon.

The Supreme Court of the United States in *Solomons v. United States*, 137 U.S. 342, 346 (1890), held:

If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto

as against his employer. That which he has been employed and paid to accomplish become, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to his inventive powers, and that which they are able to accomplish, he has sold in advance to his employer.

It is clear that an employee who is paid to develop an invention comes within the scope of the language cited.

Since Emre Oksan was employed by The Whittier Group, that is, paid compensation to develop a system and method for automated prescription management, this invention belongs to The Whittier Group and the inventor who contributed to the development of the device has a duty to assign the invention, patent application, and any patent which issues thereon to The Whittier Group and upon direction of The Whittier Group execute an application therefor. In fact, the inventor has already assigned the invention to The Whittier Group (Attached hereto as Exhibit A) but refuses to sign the Declaration of inventorship.

Mr. Oksan executed an Assignment of Invention to The Whittier Group on January 6, 2000. Moreover, Mr. Oksan assisted in the preparation of the parent, provisional application (U.S. Serial No. 60/192,643), but left the employ of The Whittier Group prior to the filing of the above-identified non-provisional application.

Mr. Oksan cannot be located to execute the papers required for filing the present patent application. The Whittier Group is believed to be entitled to make such application on behalf of and as agent for the inventor pursuant to 37 C.F.R. 1.47(b).

The required fee pursuant to § 1.17(h) is enclosed.

Respectfully submitted,

PIPER MARBURY RUDNICK & WOLFE

By: 

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Dated: July 24, 2001

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